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EXAMINER
KAU, STEVEN Y

ART UNIT	PAPER NUMBER
2625	

NOTIFICATION DATE	DELIVERY MODE
08/11/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/768,023	SAWADA, NOZOMI	
	Examiner	Art Unit	
	STEVEN KAU	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 May 2011*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *50-56,58-64 and 66-68* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *50-56,58-64 and 66-68* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/23/2011 has been entered.

Response to Amendment

2. This is in response to Applicant(s) arguments filed on 05/23/2011.

- The following is the current status of claims:

  Claims 1-19, 57 and 65 have been cancelled, and claims 66-68 have been added. Thus, claims 50-56, 58-64 and 66-68 remain pending for examination, with claims 50, 58 and 66-68 being independent. Claims 50, 51, 53, 58, 59 and 61 have been amended.

- Response to Remarks/Arguments:

  (1) Applicant's arguments, "The rejection under 35 U.S.C. § 112, first paragraph", with respect to claims 57 and 65, page 12, Remarks, 05/23/2011, have been fully considered and are persuasive. In view of claim cancelation, the rejections of claims 57 and 65 under 35 U.S.C. § 112, first paragraph is withdrawn.

  (2) Applicant's arguments, "claim rejection", pages 12-15, Remarks, 05/23/2011, with respect to claim 50 have been fully considered but are moot in view of the new ground(s) of rejection due to the amendments.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 50, 51, 53-55, 58, 59, 61-63 and 66-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumon (US 5,208,902) in view of Yoshino (US 5,289,236).

(1) Regarding claim 50.

Kumon discloses image forming apparatus comprising: a receiving unit (**Printing Control Portion of Fig. 1**) configured to receive, via a network, image data and recording medium size therefor (**referring to Fig. 1, Printing Control Portion A1 receives image data, which is transmitted from the Host System C, from Image Editing Unit B, col 4, lines 20-33**);

a plurality of supply parts respectively configured to accommodate a plurality of recording media having different sizes (**referring to Fig. 2, a plurality of paper trays, col 3, lines 27-32**);

a forming unit configured to form the image data received by the receiving unit on a substitute recording medium (**referring to Figs. 1 and 2, col 3, lines 118-26**), accommodated in one of the plurality of supply parts and having a size different from the recording medium size received by the receiving unit, when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size (**referring to Fig. 2, paper supply path has paper size detection device, e.g., 45 and 46, col 3, lines 30-47, col 7, lines 38-59; Figs. 8a-8b**).

Kumon does not teach that a reducing unit configured to reduce the image data when the size of the substitute recording medium is smaller than the recording medium size, wherein the forming unit forms the image data on the substitute recording medium having a first size that is predetermined with respect to the recording medium size, without reduction by the reducing unit, when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size but include the first size; and wherein the forming unit forms the image data on the substitute recording medium having a second size that is larger than the first size and is predetermined with respect to the recording medium size, without reduction by the reducing unit, when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size nor the first size but include the second size.

Yoshino teaches that a reducing unit (**Magnify/Reducing Unit**) configured to reduce the image data when the size of the substitute recording medium is smaller than the recording medium size, wherein the forming unit forms the image data on the substitute recording medium having a first size that is predetermined (**selected**) with respect to the recording medium size (**col 2, lines 9-29**), without reduction by the reducing unit (**100% magnification is restored**), when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size but include the first size (**col 11, lines 1-5, and as an example, see col 12, lines 37-52**); and wherein the forming unit forms the image data on the substitute recording medium having a second size that is larger than the first size and is predetermined (**different paper size/type are prioritized and stored in a memory, col 11, lines 24-43**) with respect to the recording medium size, without reduction by the reducing unit, when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size nor the first size but include the second size (**col 11, lines 1-5 and line 65 to col 12, line 6**).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kumon to include "a reducing unit configured to reduce the image data when the size of the substitute recording medium is smaller than the recording medium size, wherein the forming unit forms the image data on the substitute recording medium having a first size that is predetermined with respect to the recording medium size, without reduction by the reducing unit, when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size but include the first size; and wherein the forming unit forms the image data on the substitute recording medium having a second size that is larger than the first size and is predetermined with respect to the recording medium size, without reduction by the reducing unit, when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size nor the first size but include the second size" as taught by Yoshino. The motivation for doing so would have been to enhance the image forming apparatus that image forming operation will continue even the specified size of paper is exhausted as specified by Yoshino (Summary of the invention, Yoshino); and further it is easily implemented by one or other in the art with a predictable

result. Therefore, it would have been obvious to combine Yoshino with Kumon to obtain the invention as specified in claim 50.

(2) Regarding claim 51, depending to claim 50.

Kumon does not teach that wherein the forming unit forms the image data received by the receiving unit, without reduction by the reducing unit, on the substitute recording medium having the first size that is a smallest size amongst the plurality of recording media accommodated in the plurality of supply parts, when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size.

Yoshino teaches that wherein the forming unit forms the image data received by the receiving unit, without reduction by the reducing unit, on the substitute recording medium having the first size that is a smallest size amongst the plurality of recording media accommodated in the plurality of supply parts, when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size (see the discussion in claim 50 above).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kumon to include "the forming unit forms the image data received by the receiving unit, without reduction by the reducing unit, on the substitute recording medium having the first size that is a smallest size amongst the plurality of recording media accommodated in the plurality of supply parts, when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size" as taught by Yoshino. The motivation for doing so would have been to enhance the image forming apparatus that image forming operation will continue even the specified size of paper is exhausted as specified by Yoshino (Summary of the invention, Yoshino); and further it is easily implemented by one or other in the art with a predictable result. Therefore, it would have been obvious to combine Yoshino and Kumon to obtain the invention as specified in claim 50.

(3) Regarding claim 53, depending to claim 50.

Kumon does not teach that a storage unit configured to store a priority order of substitute recording medium sizes to be used when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size received by the receiving unit.

Yoshino teaches that a storage unit configured to store a priority order of substitute recording medium sizes to be used when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size received by the receiving unit (see the discussion in claim 50 above).

(4) Regarding claim 54, depending to claim 50.

Kumon does not teach that a selecting unit configured to select one of forming the image data reduced by the reducing unit on the substitute recording medium based on the size of the substitute recording medium and forming the image data, received by the receiving unit on the substitute recording medium without reduction by the reduction unit.

Yoshino teaches that a selecting unit (**Fig. 2**) configured to select one of forming the image data reduced by the reducing unit on the substitute recording medium based on the size of the substitute recording medium and forming the image data, received by the receiving unit on the substitute recording medium without reduction by the reduction unit (**col 5, lines 66 to col 6, line 7 and col 12, lines 1-6**).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kumon to include "a selecting unit configured to select one of forming the image data reduced by the reducing unit on the

substitute recording medium based on the size of the substitute recording medium and forming the image data, received by the receiving unit on the substitute recording medium without reduction by the reduction unit" as taught by Yoshino. The motivation for doing so would have been to enhance the image forming apparatus that image forming operation will continue even the specified size of paper is exhausted as specified by Yoshino (Summary of the invention, Yoshino); and further it is easily implemented by one or other in the art with a predictable result. Therefore, it would have been obvious to combine Yoshino and Kumon to obtain the invention as specified in claim 54.

(5) Regarding claim 55, depending to claim 50.

Kumon does not teach that a selecting unit configured to select one of forming the image data reduced by the reducing unit on the substitute recording medium based on the size of the substitute recording medium and forming the image data received by the receiving unit in parts on a plurality of substitute recording media without reduction by the reduction unit.

Yoshino teaches that a selecting unit configured to select one of forming the image data reduced by the reducing unit on the substitute recording medium based on the size of the substitute recording medium and forming the image data received by the receiving unit in parts on a plurality of substitute recording media without reduction by the reduction unit (See the discussion in claims 50 and 54 above).

(6) Regarding claims 58, 59, 61, 62, 63.

Claims 58, 59, 61 62 and 63 are directed to an image forming method of claim 58 and recite identical features as claims 50, 51, 53, 54 and 55. Thus, claims 58, 59, 61 62 and 63 are rejected for the same reasons discussed in these claims above.

(7) Regarding claim 68.

Kumon discloses an image forming system connectable to a network, comprising:
a receiving unit configured to receive, via the network, image data and recording medium size therefor (**discussed in claim 50 above**);
a plurality of supply parts respectively configured to accommodate a plurality of recording media having different sizes (discussed in claim 50 above); a forming unit, coupled to the receiving unit (**referring to Fig. 1, Printing Control Portion receiving image data from Image Editing Unit and Printing Portion processes image forming operation**), configured to form the image data received by the receiving unit on a substitute recording medium, accommodated in one of the plurality of supply parts and having a size different from the recording medium size received by the receiving unit (discussed in claim 50 above), when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size (discussed in claim 50 above).

Kumon does not teach that a reducing unit, coupled to the receiving unit configured to reduce the image data when the size of the substitute recording medium is smaller than the recording medium size, wherein the forming unit forms the image data on the substitute recording medium having a first size that is predetermined with respect to the recording medium size, without reduction by the reducing unit, when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size but include the first size, and wherein the forming unit forms the image data on the substitute recording medium having a second size that is larger than the first size and is predetermined with respect to the recording medium size, without reduction by the reducing unit,

when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size nor the first size but include the second size.

Yoshino teaches that a reducing unit, coupled to the receiving unit configured to reduce the image data when the size of the substitute recording medium is smaller than the recording medium size, wherein the forming unit forms the image data on the substitute recording medium having a first size that is predetermined with respect to the recording medium size, without reduction by the reducing unit, when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size but include the first size, and wherein the forming unit forms the image data on the substitute recording medium having a second size that is larger than the first size and is predetermined with respect to the recording medium size, without reduction by the reducing unit, when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size nor the first size but include the second size (see the discussion in claim 50 above).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kumon to include "a reducing unit configured to reduce the image data when the size of the substitute recording medium is smaller than the recording medium size wherein the forming unit forms the image data on the substitute recording medium having a first size that is predetermined with respect to the recording medium size, without reduction by the reducing unit, when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size but include the first size; and wherein the forming unit forms the image data on the substitute recording medium having a second size that is larger than the first size and is predetermined with respect to the recording medium size, without reduction by the reducing unit, when the different sizes of the plurality of recording media accommodated in the plurality of supply parts do not include the recording medium size nor the first size but include the second size" as taught by Yoshino. The motivation for doing so would have been to enhance the image forming apparatus that image forming operation will continue even the specified size of paper is exhausted as specified by Yoshino (Summary of the invention, Yoshino); and further it is easily implemented by one or other in the art with a predictable result. Therefore, it would have been obvious to combine Yoshino with Kumon to obtain the invention as specified in claim 68.

(8) Regarding claims 66 and 67.

Claims 66 and 67 are directed to an image forming method and a non-transitory computer-readable recording medium, Respectively. Claims 66 and 67 recite identical features as claims 50 and 68. Thus, claims 66 and 67 are rejected for the same reasons discussed in claims 50 and 68 above.

5. Claims 52 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumon (US 5,208,902) in view of Yoshino (US 5,289,236) as applied to claims 50 and 58 above, and further in view of Ishikura et al (US RE37,812).

(9) Regarding claim 52, in accordance with claim 50.

Kumon does not explicitly teach wherein one of the plurality of recording media having a size B4 is used as the substitute recording medium when the recording medium size received by the receiving unit is a size A4, a recording medium having the size A4 is unavailable, and one of the plurality of recording media having a size larger than the size A4 is to be used as the substitute recording medium, one of the plurality of recording media having a size A3 is used as the substitute recording medium when a recording medium having the size B4 is unavailable, and the forming unit forms the

image data received by the receiving unit, without reduction by the reducing unit, on the substitute recording medium having the B4 size or the A3 size.

Ishikura teaches that one of the plurality of recording media having a size B4 is used as the substitute recording medium when the recording medium size received by the receiving unit is a size A4, a recording medium having the size A4 is unavailable, and one of the plurality of recording media having a size larger than the size A4 is to be used as the substitute recording medium, one of the plurality of recording media having a size A3 is used as the substitute recording medium when a recording medium having the size B4 is unavailable, and the forming unit forms the image data received by the receiving unit, without reduction by the reducing unit, on the substitute recording medium having the B4 size or the A3 size (**sheet size of B4 is used for A4 size of original, col 10, lines 43-45**).

Having an image forming apparatus of Kumon reference and then given the well-established teaching of de Ishikura reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kumon reference by applying the known technique of "one of the plurality of recording media having a size B4 is used as the substitute recording medium when the recording medium size received by the receiving unit is a size A4, a recording medium having the size A4 is unavailable, and one of the plurality of recording media having a size larger than the size A4 is to be used as the substitute recording medium, one of the plurality of recording media having a size A3 is used as the substitute recording medium when a recording medium having the size B4 is unavailable, and the forming unit forms the image data received by the receiving unit, without reduction by the reducing unit, on the substitute recording medium having the B4 size or the A3 size" as taught by Ishikura reference. The motivation for doing so would have been to improve the image reproduction throughput and thus to improve the productivity by using substitute paper with close size when the designated paper size unavailable without hampering print jobs requested by other users, and further the disclosure provided could easily be established for one another with predictable results.

(10) Regarding claim 60, depending to claim 58.

Claim 60 recites identical features as claim 52 and is rejected for the same reason discussed in claim 52 above.

6. Claims 56 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumon (US 5,208,902) in view of Yoshino (US 5,289,236) as applied to claims 51 and 59 above, and further in view of Okada et al (US 6,611,347)

(11) Regarding claim 56, depending to claim 51.

Kumon does not teach that wherein the forming unit forms the image data received by the receiving unit at a predetermined position on the substitute recording medium.

Okada discloses wherein the forming unit forms the image data received by the receiving unit at a predetermined position on the substitute recording medium (**referring to Fig. 10, Steps 4, and 6-9, bi-map image is developed prior to form image data on the recording paper, col 12, lines 20-29 and line 45-53**).

Having an image forming apparatus of Kumon reference and then given the well-established teaching of de Okada reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kumon reference by applying the known technique of " wherein the forming unit forms the image data received by the receiving unit at a predetermined position on the substitute recording medium " as taught by Okada reference. The motivation for doing so would have been to enhance the image forming apparatus in order to match the paper size used

as specified by Okada (col 12, lines 20-25), and further the disclosure provided could easily be established for one another with predictable results.

(12) Regarding claim 64, depending to claim 59.

Claim 64 recites identical features as claim 51 and therefore is rejected for the same reasons discussed in claim 51 above.

CONTACT INFORMATION

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Kau whose telephone number is 571-270-1120 and fax number is 571-270-2120. The examiner can normally be reached on M-F, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/STEVEN KAU/
Examiner, Art Unit 2625
August 7, 2011